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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/768,535

01/30/2004

Martin Arthur Fabrizio

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03/25/2005

PIONEER HI-BRED INTERNATIONAL INC.

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EXAMINER

IBRAHIM, MEDINA AHMED

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/768,535

Applicant(s)

FABRIZIUS ET AL.

Examiner

Medina A Ibrahim

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-8 are pending and are examined.

#### ***Abstract***

The abstract of the disclosure is objected to because it is not commensurate with the scope of the claimed invention. Correction is required. See MPEP § 608.01(b).

#### ***Specification***

The disclosure is objected to for including blank spaces on page 48. Appropriate correction is required.

#### ***Claim Objections***

At claims 2 and 3, ---,--- should be inserted before "wherein".

At claim 5, ---produced--- should be inserted after "cells".

At claim 6, "A" should be changed to ---The--- because it refers to a previous claim. Also, ---the--- should be inserted before "cells"; "of the tissue culture" should be deleted; and "obtained" should be changed to ---produced---.

At claim 7, "and" in line 1 should be replaced with ---, ---.

At claim 8, the ": " should be deleted. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year

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prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Grace III et al (US 5, 942, 668 )

Grace et al teach soybean variety 92B05, seed and plant of said variety, and a method of producing a progeny plant comprising crossing the 92B05 plant with a different soybean plant (at least the Abstract). It appears that the claimed plants and seeds of the instant invention may be the same as the 92B05, given that they exhibit similar traits associated with plant morphology such as purple flower, Tan pod, brown hila, tawny pubescence, and physiological characteristics such as tolerance to phytophthora 4 and 7, and intermediate resistance to iron chlorosis (columns 8 ). Grace et al is silent with respect to the herbicide resistance of 92B05, while the instant application is silent brown stem rot. The small variations in the % of protein, % oil content, and seed size appears to be environmental influence. Grace et al further teaches tissue culture and regeneration of soybean plants, as well as plant parts pollen and ovule (columns 17-18). Hence, the instantly claimed plants are indistinguishable from the prior art 92B05 soybean variety based on the teachings of the specification.

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Alternatively, Grace et al teaches soybean variety 92B05, while the instant invention is directed to soybean variety XB09J04. The instant specification fails to describe adequate characteristics of the XB09J04 to distinguish the soybean variety of the prior art.

If the claimed soybean/seed is not identical to 92B05, then it appears that they differ from the 92B05 plants, plant parts, and seeds due to minor morphological variation, wherein said minor morphological variation would be expected to occur upon cultivation of said plants on different soil types with different nutrient supplements and under different environmental growth conditions such as temperature, humidity, light, etc. and wherein said minor morphological variation would not confer a patentable distinction to 92B05.

The Office is not equipped to provide evidence to establish that the prior art variety is essentially different from the instantly claimed variety. In the absence of evidence to the contrary, the burden is on the Applicant to provide that the claimed product is different from those of the prior art and to establish patentable differences. See *In re Best* 562dF.2d 1252 USPQ 430 (CCPA 1977) and *Ex parte Gray* 10 USPQ 2d 1922 (PTO Bd.Pat & Int. 1989).

Therefore, the claimed invention is anticipated by or, in the alternative, is obvious over the prior art, absent evidence to the contrary.

**Remarks**

No claim is allowed.

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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Medina A. Ibrahim whose telephone number is (571) 272-0797. The Examiner can normally be reached Monday -Thursday from 8:00AM to 5:30PM and every other Friday from 9:00AM to 5:00 PM. Before and after final responses should be directed to fax nos. (703) 872-9306 and (703) 872-9307, respectively.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Amy Nelson, can be reached at (571) 272-0804.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3/19/05  
Mai



**MEDINA A. IBRAHIM**  
**PATENT EXAMINER**